

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Goldberg

Docket No. 3715P2308CIP2

Serial No. 10/066,243

Examiner: Duong, Oanh L.

Filed: February 1, 2002

Art Unit: 2155

For: METHOD AND SYSTEM FOR MODIFYING THE CONTENT OF
E-MAIL TRANSMISSIONS BASED ON CUSTOMIZATION SETTINGS

APPEAL BRIEF

This Appeal Brief is submitted pursuant to the provisions of 37 CFR 41.37,
together with the requisite fee in the amount of \$250.00, pursuant to 37 CFR 41.20 (b)(2).
Also included is a Request for Oral Hearing, along with the requisite fee.

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I. REAL PARTY IN INTEREST

The real party in interest is Bernel Goldberg.

II. RELATED APPEALS AND INTERFERENCES

None

III. STATUS OF CLAIMS

Claims on appeal: 1-5, 8-14, 17-23, 26 and 27

Claims objected to: 6, 7, 15, 16, 24 and 25

IV. STATUS OF AMENDMENTS

An amendment is being filed concurrently herewith to rewrite objected to dependent claims 6, 7, 15, 16, 24 and 25 into independent form as permitted under 37 CFR 41.33 (a)(2). These claims are not the subject of this appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The independent claims involved in this appeal are Claims 1, 10 and 19. These independent claims 1, 10 and 19 recite in part:

“receiving a user input indicating that an e-mail message is complete [Claim 19: has been completed];

checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting; and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.”

Dependent appealed claims 3-5, 12-14, 21-23 are directed to said user input instructing an e-mail program to send, save, or check said e-mail message indicating that an e-mail message is complete.

Dependent appealed claims 8- 9, 17-18, and 26-27 are directed to copy recipient list and urgency level customization settings and the modification of the text to include respectively a “cc:” list and an indication of said level of urgency (i.e. message priority).

Dependent appealed claims 2, 11 and 20 are directed to parsing the e-mail message for strings that already indicate to the recipient that a customization is present, and the prompting of the user to insert information is then skipped.

The explanation for the subject matter defined in each of these claims may be found in the Specification as follows:

The claimed method and system prompts the user to insert information within the e-mail message text or subject heading in response to detecting customization setting(s) that will indicate the presence of a customization to the recipient of the e-mail message. e.g.s Page 8, lines 21-22; Page 9, line 24-page 10, line 3. Shown below is Table 1 reproduced from p. 10, lines 15-25 of the Specification indicating exemplary

customization features and the corresponding prompt for action/information inserted within the e-mail text or subject heading. Exemplary user prompts 37, 42, 44 are shown in FIG. 2. (Claims 1, 8-9, 10, 17-18, 19, and 26-27).

Customization Feature	Exemplary Action
Message Priority	Prompt to insert priority (e.g., "Urgent") in subject line
Encryption	Prompt to insert "Encrypted" at bottom of message
cc: and bcc:	Prompt to generate cc: list at bottom of message text (and optionally bcc: list)
Electronic Signature	Prompt to add "signed electronically" to bottom of message text
Attachment	Prompt to add "Attachment(s)" at the bottom of message text
Message type	Prompt to add message type (e.g., "Private") in subject line

By checking the e-mail message customization settings prior to sending or upon saving an e-mail message, the e-mail program can prompt the sender to insert information within the e-mail message in response to detecting the customization setting during a check or scan of the settings when the user saves, checks or sends the message indicating that the e-mail message is complete. e.g. Page 9, lines 1-6 and lines 16-20. (Claims 1, 3-5, 10, 12-14, 19, and 21-23)

In an alternative embodiment, the message can be parsed for strings that already indicate to the recipient that a customization is present, and the prompting of the sender to insert information is then skipped e.g. Page 9, lines 6-9. (Claims 1, 2, 10, 11, 19, and 20).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 are unpatentable under 35 U.S.C.103(a) over Walsh (U.S. 2002/0107924 A1) in view of Tsai (U.S. 6,839,741 B1).
2. Whether Claims 3-5, 12-14 and 21-23 are unpatentable under 35 U.S.C. 103(a) over Walsh in view of Tsai, and further in view of Chrabaszcz (U.S. 6,073,133).
3. Whether claims 9, 18, and 27 are unpatentable under 35 U.S.C.103(a) over Walsh in view of Tsai, and further in view of Okumura et al. (Okamura)(US 2002/0049793A1).

VII. ARGUMENT

1. Whether Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 are unpatentable under 35 U.S.C.103(a) over Walsh (U.S. 2002/0107924 A1) in view of Tsai (U.S. 6,839,741 B1).

Independent claims 1, 10 and 19 recite in part:

“checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting; and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.”

The Examiner has flatly conceded that “Walsh does not explicitly teach modify the text of the email message to notify a recipient of a detected customization setting.” (Final Rejection dated 12/15/05.). None of the references combined with Walsh, including Tsai, supply this deficiency. Yet, the Examiner nevertheless maintains that the claimed invention is obvious, for purposes of the obviousness rejection under 35 USC 103. Applicant respectfully submits that the Examiner’s rejection is fundamentally flawed and must be overturned.

Walsh is directed to attaching actual documents (secondary documents) to an e-mail (primary document) if the e-mail text already includes “indicators” or references to “attachments”, “enclosures” or the like. Similarly, Walsh is also directed to creating a list of “CC” recipients if the e-mail text already includes “indicators” such as the term “CC” or phrase “I have CC’d”. This is to be contrasted with Applicant’s invention in which, for example, actual documents have already been attached or CC recipients already listed in the CC line, but the text of the e-mail message does not include reference to such attached documents or that there are CC recipients. In this example, the user of

Applicant's invention may be prompted to add the terms "attachments" and "cc" or the like to the text of the e-mail message before sending, checking, or upon saving of the e-mail message. There is absolutely no description or suggestion in Walsh to modify the text of the e-mail message, notwithstanding the Examiner's rejection and as conceded by the Examiner.

The Examiner further states that modifying the text of an e-mail message to notify a recipient of a detected customization setting is known from Tsai (U.S. 6,839,741) and that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walsh to insert text to notify a recipient of a detected customization as in Tsai "to allow recipient to easily recognize the existence of the attachment file/customization setting by only reading the text of the email message..." However, Tsai is concerned with yet another methodology, which consists of stripping attachments from e-mail and inserting text notifying the recipient that the attachment has been stripped. In the context of the present invention, Tsai discloses removing a customization and indicating to the e-mail recipient that the e-mail message has been automatically modified to *remove* the customization. Moreover, Tsai is directed to an attachment server 90 adding text after the e-mail message has already left the user (Tsai, Column 6, lines 60-66) unlike Applicant's claimed method and system which prompts the user to modify the text before the message is actually sent. Therefore, the proposed combination of Walsh and Tsai does not result in Applicant's invention.

Modifying Walsh with Tsai would also defeat the purpose of Walsh. More specifically, in Walsh, the reference to attachments is already in the text (e.g. by indicators such as "attachments" or "enclosures" or the like) as a reminder that

documents should be attached. The text supplied by Tsai in the combination proposed by the Examiner would redundantly provide a second reference to attachments, but that said attachments had been stripped or removed (rather than attached as in Walsh). Therefore, the proposed combination of Walsh with Tsai is inappropriate. Nothing in Walsh in combination with Tsai suggests the methodology and system of the claimed invention, which is to offer the user modification of the text of the e-mail message to notify a recipient of a detected customization setting.

Based on the foregoing, Applicant respectfully submits that independent Claims 1, 10, and 19 are patentable over the cited combination. Because independent Claims 1, 10, and 19 are believed to be patentable, claims 2, 8, 11, 17, 20 and 26 dependent thereon are also believed to be patentable and any rejection thereof has been obviated by the remarks above with respect to the independent claims.

Further, it is submitted that each of the rejected dependent claims set forth further important distinguishing features of the present invention not shown, taught or suggested by the combination of Walsh and Tsai. With respect to dependent claims 2, 11, and 20, the Examiner indicates that Walsh teaches parsing said message to determine whether or not said user has already entered text that will notify[sic] a recipient of a particular customization setting, citing to p. 2, ¶23, and in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting (i.e. if the result of the determination is negative, then only primary document is processed, citing to p. 2, ¶ 21). Applicant disagrees.

Walsh, p. 2, ¶21, in describing FIG. 2 there:

“In a first step 100, processor 10 receives primary document 50 from first storage device 20. In a second step 110,

processor 110 determines whether any of the plurality of words in the primary document 50 in an indicatorIf the result of the determination at step 110 is positive, then at step 130, processor IO may then receive a user input indicating the filename and/or the location of secondary document 60. In step 140, processor 10 then attaches secondary document 60 to primary document 50 for further processing at step 150. If the result of the determination at step 110 is negative, then only primary document 50 is processed further at step 120.”

In Applicant’s claimed invention, if the e-mail text already notifies a recipient of a particular customization setting, the prompt is skipped. By contrast, in Walsh, if the email text includes the indicator (i.e. is positive), the prompt to attach a secondary document is given (not skipped). This rejection underscores the Examiner’s fundamental misunderstanding of Walsh as discussed above in the preceding section.

With respect to dependent claims 8, 17, and 26, the Examiner indicates that Walsh teaches the modification of text to include a cc list, citing to p. 4, ¶¶ 36-38. To the contrary, Walsh refers simply to creating a CC list or adding additional people to an existing CC list and not modifying the text of the e-mail message. Indeed, Walsh states: “A common problem in the e-mail context is that a user may indicate in primary document that a copy will be sent to another person, but forgets to create the CC list or forgets to include a specific secondary recipient.” Para. 37. In Applicant’s e-mail message, there is no indication in the text of the email message that a copy will be sent to another person until a user automatically modifies the text of said e-mail message “in response to said checking detecting a particular customization setting.” Based on the foregoing, the rejection of Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 on the basis of the Walsh and Tsai combination was in error.

2. Whether Claims 3-5, 12-14 and 21-23 are unpatentable under 35 U.S.C. 103(a) over Walsh in view of Tsai, and further in view of Chrabaszcz (U.S. 6,073,133).

The Examiner has further rejected dependent Claims 3-5, 12-14, and 21-23 under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of Tsai, and further in view of Chrabaszcz (U.S. 6,073,133). The Examiner acknowledges that neither the Walsh nor the Tsai reference explicitly teach user input as claimed, but that “Chrabaszcz teaches the user input instructing an e-mail program to send the e-mail message” (Office Action, page 3, para. 3).

Applicant respectfully submits that this rejection was also in error. Applicant hereby incorporates by reference his discussion above regarding the combination of Walsh and Tsai. Chrabaszcz does not supply the deficiency of Walsh-Tsai, namely the modification of the e-mail text. Chrabaszcz is concerned with determining when a user may intend to attach an attachment based on text included in the message and not *modifying the text of a message to indicate the presence of a customization*.

As independent claims 1, 10, and 19 are believed patentable over the combination of Walsh and Tsai, rejected dependent claims 3-5, 12-14 and 21-23 should similarly be patentable. Accordingly, Applicant respectfully submits that the rejection of claims 3-5, 12-14 and 21-23 was in error.

3. Whether claims 9, 18, and 27 are unpatentable under 35 U.S.C.103(a) over Walsh in view of Tsai, and further in view of Okumura et al. (Okamura)(US 2002/0049793A1).

Claims 9, 18, and 27 have also been rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Tsai, and further in view of Okumura et al (U.S. 2002/0049793). Claims 9, 18 and 27, which are dependent claims, add the feature of modifying the subject line of the e-mail message to indicate a level of urgency after detecting a customization setting of message priority.

Applicant incorporates by reference his discussion above regarding the combination of Walsh and Tsai. The Examiner indicates that Walsh-Tsai does not explicitly teach modifying a subject line of an e-mail message to include an indication of urgency, but that Okumura teaches modifying the subject line of the e-mail message. The Examiner concludes that “[i]t would have been obvious to a person of ordinary skill in the art at the time of [sic] the invention was made to combine the teachings of Walsh-Tsai to include modifying a subject line of the email message because it would enable an improper subject to be eliminated”, relying on Okumura, p. 4, ¶88. Again, Walsh-Tsai does not make modifying the text including the subject line obvious and Okumura does not supply the deficiency.

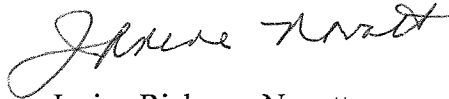
Moreover, the present invention is directed to modifying the subject line of the email message to add, for example, "Urgent" or "Private" or the like upon detection of a customization setting such as respectively, a priority or message type customization setting which is patentably different from “enable[ing] an improper subject to be eliminated.”

Conclusion

For the reasons stated above, Applicant respectfully submits that the final rejection of Claims 1-5, 8-14, 17-23, 26 and 27 was in error, and that these claims should be allowed. Accordingly, Applicant respectfully urges the Board to reverse the Examiner's final rejection of these claims.

The fees required by this appeal and request for oral hearing are tendered herewith. No additional fee or extension of time is believed to be required, however, in the event an additional fee or extension of time is required, please charge that fee or extension of time requested to our Deposit Account No 23-0830.

Respectfully submitted,



Janine Rickman Novatt
Reg. No. 32, 593
Attorney for Applicant

5/1/06

Weiss & Moy P.C.
4204 N. Brown Avenue
Scottsdale, AZ 85251
(480)994-8888 (phone)
(480) 947-2663 (fax)

VIII. CLAIMS APPENDIX

1. A method for completing an e-mail transmission, comprising:

 receiving a user input indicating that an e-mail message is complete;

 checking customization settings to determine whether or not to offer modification

of the text of the e-mail message to notify a recipient of a detected customization setting;

and

 in response to said checking detecting a particular customization setting,

generating a user prompt to permit a user to automatically modify the text of said e-mail
message.
2. The method of Claim 1, further comprising:

 parsing said message to determine whether or not said user has already entered

text that will notifying a recipient of a particular customization setting; and

 in response to said parsing detecting said entered text, skipping said generating of
said user prompt for said particular customization setting.
3. The method of Claim 1, wherein said user input indicating that said e-mail
message is complete is a user input instructing an e-mail program to send said e-mail
message.
4. The method of Claim 1, wherein said user input indicating that said e-mail
message is complete is a user input instructing an e-mail program to save said e-mail
message.

5. The method of Claim 1, wherein said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to check said e-mail message.
8. The method of Claim 1, wherein said particular customization setting is a copy recipient list, and wherein said modifying modifies said text to include a "cc:" list.
9. The method of Claim 1, wherein said particular customization indicates a level of urgency of said e-mail message and wherein said modifying modifies a subject line of said message to include an indication of said level of urgency.
10. A system for completing an e-mail transmission, comprising:
- a memory for storing program instructions and data;
 - a processor coupled to said memory for executing said program instructions; and
 - a user input device coupled to said processor for receiving user input, wherein
- said program instructions include instructions for
- receiving a user input indicating that an e-mail message has been completed,
 - checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting, and
 - in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.

11. The system of Claim 10, wherein said program instructions further comprise program instructions for:

parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting; and

in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting.

12. The system of Claim 10, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to send said e-mail message.

13. The system of Claim 10, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to save said e-mail message.

14. The system of Claim 10, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to check said e-mail message.

17. The system of Claim 10, wherein said particular customization setting is a copy recipient list, and wherein said program instructions for modifying modify said text to include a "cc:" list.

18. The system of Claim 10, wherein said particular customization indicates a level of urgency of said e-mail message and wherein said program instructions for modifying modify a subject line of said message to include an indication of said level of urgency.

19. A computer program product comprising signal-bearing media containing program instructions for execution within a general purpose computer, wherein said program instructions comprise program instructions for:

receiving a user input indicating that an e-mail message has been completed,

checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting, and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.

20. The computer program product of Claim 19, wherein said program instructions further comprise program instructions for:

parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting; and

in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting.

21. The computer program product of Claim 19, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to send said e-mail message.

22. The computer program product of Claim 19, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to save said e-mail message.

23. The computer program product of Claim 19, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to check said e-mail message.

26. The computer program product of Claim 19, wherein said particular customization setting is a copy recipient list, and wherein said program instructions for modifying modify said text to include a "cc:" list.

27. The computer program product of Claim 19, wherein said particular customization indicates a level of urgency of said e-mail message and wherein said program instructions for modifying modify a subject line of said message to include an indication of said level of urgency.

IX. EVIDENCE APPENDIX

none

IX. RELATED PROCEEDINGS APPENDIX

none